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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,450	07/25/2001	Bill Kwong	BHT-3092-233	4660

7590 04/02/2004  
Dougherty & Troxell  
ONE SKYLINE PLACE  
SUITE 1404  
5205 LEESBURG PIKE  
FALLS CHURCH, VA 22041

EXAMINER

AUVE, GLENN ALLEN

ART UNIT	PAPER NUMBER
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2111

DATE MAILED: 04/02/2004

2

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/911,450

Applicant(s)

KWONG, BILL

Examiner

Glenn A. Auve

Art Unit

2111

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)            |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____  |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 112*

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. At least claims 1 and 7 include the limitation that the data storage device can be connected to the I/O port of any type of interface (claim 1) or that the second interface is "any future input/output interface" (claim 7). The specification includes discussion of connecting the device using USB, PCMCIA, and Firewire (IEEE-1394) interfaces. But the disclosure is not enabling for either the use of "any" interface or "any future interface".

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 1 is rejected because it is not clear what is meant by "A set of Universal Storage Interface Bus device" on line 1. Specifically it is not clear how one can have a set of device. It is also not clear what is meant by "the third connector coupling with the second connector, converts the IDE signal and connector of the IDE storage device into USIB signal coming out of

Art Unit: 2111

the fourth connector, a standard MC-36 connector". How does the third connector convert the IDE signal and connector of the device into USIB signal? This whole section of the claim is very awkwardly worded and difficult to understand.

Claim 1 is also rejected based on lack of positive antecedent basis of "the IDE signal" on line 7, "the data storage device" on line 15, and "the appropriate USIB interface conversion cable" on lines 16-17.

Claims 2-10 are rejected because they depend on claim 1.

Claim 4 is also rejected because it is not clear what is meant by "a UBS interface" on line 2. It appears as though applicant may mean a USB interface.

### ***Conclusion***

5. Claims 1-10 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

6. The following is a statement of reasons for the indication of allowable subject matter: the USIB conversion cable limitations in combination with the other limitations in claim 1 are not shown in the prior art and would not have been obvious.

The reference to Chang (US Pat. No. 6,560,099 B1) appears to have some similarities to applicant's admitted prior art in that the drive unit includes an ASIC for converting signals so that an IDE, USB, Firewire, or PCMCIA interface can be used. Chang however places each of the interfaces on the back of the drive unit enclosure and the user simply selects whether he wants to use an IDE connection or USB connection (as shown in their examples, but the interface could also be at least IEEE-1394 or PCMCIA) and flips a switch to choose the interface and

plugs in the appropriate cable. Chang does not show the USB interface conversion board in the interface conversion cable that plugs into a standard MC-36 connector.

Moroz et al (US Pat. No. 5,941,965) shows a universal docking station which uses a single PCMCIA connection to couple a computer with a docking station that connects with multiple peripherals. Moroz shows using a single standardized connector to couple to the disparate devices, however they do not show the limitations claimed by applicant.

Blackborow et al. (US Pat. No. 5,297,067) merely shows hot plugging of a disk drive to a computer.

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure as noted above.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Glenn A. Auve whose telephone number is (703) 305-9638. The examiner can normally be reached on M-Th 8:00 AM-5:30 PM, every other Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mark Rinehart can be reached on (703) 305-4815. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Application Number: 09/911,450

5

Art Unit: 2111

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Glenn A. Auve  
Primary Examiner  
Art Unit 2111

gaa  
March 31, 2004